

## **REMARKS**

Applicants respectfully request reconsideration of the present application. No new matter has been added to the present application. Claims 1-6, 8-26, 28-46, and 48-60 have been rejected in the Office action. No claims have been amended, no new claims have been added, and no claims have been canceled in this Response. Accordingly, claims 1-6, 8-26, 28-46, and 48-60 are pending herein. Claims 1-6, 8-26, 28-46, and 48-60 are believed to be in condition for allowance and such favorable action is respectfully requested.

### **Rejections based on 35 U.S.C. § 103**

#### A. Applicable Authority

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” See MPEP § 2143. Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in

light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985).” *Id.* See also MPEP § 706.02(j) and § 2142.

B. Rejections based on Waltrous and Rapaport

Claims 1-6, 8-26, 28-46, and 48-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,629,937 to Waltrous, (“the Waltrous reference”) in view of U.S. Patent No. 5,926,526 to Rapaport et al. (“the Rapaport reference”). Applicants respectfully submit that a *prima facie* case of obviousness has not been established for claims 1-6, 8-26, 28-46, and 48-60 . In particular, the Waltrous and Rapaport references, either alone or in combination, fail to teach or suggest all the claim limitations for each of claims 1-6, 8-26, 28-46, and 48-60. Additionally, there is no motivation or suggestion to combine or modify the Waltrous and Rapaport references to achieve the claimed invention. Accordingly, Applicants respectfully traverse this rejection, as hereinafter set forth.

Referring initially to independent claim 1, a method in a computer system for translating medical test results into plain language is recited. The method includes receiving a medical test result for a type of medical test and determining if the medical test result will be automatically interpreted independent of clinician input or if the medical test result will be interpreted using clinician input. If the medical test result will be automatically interpreted independent of clinician input, at least one template associated with the type of medical test is identified. A template matching the medical test result is selected, and a plain language explanation based on the selected template is outputted.

In contrast to the invention of claim 1, the Waltrous reference discusses a diagnostic decision support system for the auditory evaluation of anatomical features. See, e.g., *Waltrous*, Abstract; col. 2, lines 31-33. The system facilitates physicians in providing objective

and accurate diagnosis of auditory signals. *Id.*, col. 3, lines 7-10. As such, the system in the Waltrous reference is clearly intended to assist physicians. *Id.*, col. 3, lines 7-10; col. 4, lines 30-32. For instance, the system may provide diagnostic decision support to assist physicians in deciding whether to pursue further diagnostic tests for patients. *Id.*, col. 4, lines 30-33. At a user's discretion, the user may interact with the system locally (i.e., in the vicinity of a patient) or remotely from the patient. *Id.*, col. 3, lines 20-24.

Applicants respectfully submit that the Waltrous reference fails to teach or suggest all the limitations of claim 1. First, the Waltrous reference fails to teach or suggest "determining if the medical test result will be automatically interpreted independent of clinician input or if the medical test result will be interpreted using clinician input." On page 3, the Office Action alleges that the Waltrous reference discusses this limitation with reference to the determination of whether local or remote operation will be performed. Applicants respectfully disagree with this conclusion. In particular, the cited aspect of the Waltrous reference merely indicates that a user may interact with the system either locally (i.e., in the vicinity of the patient) or remotely (i.e., not in the vicinity of the patient). *See, e.g., Waltrous*, col. 3, lines 20-23. A determination of whether a user will interact with the system locally or remotely clearly does not reflect a determination of whether a "medical test result will be automatically interpreted independent of clinician input or if the medical test result will be interpreted using clinician" as recited in claim 1. Local or remote interaction with a system is significantly different from determination of whether a medical test result will be automatically interpreted independent of clinician input. Moreover, the determination of local or remote operation in the Waltrous reference is not an automatic determination but instead is based on user input. In particular, the Waltrous reference clearly indicates that "[t]he system also allows local operation (i.e., operation

in the vicinity of a patient) and remote operation, at a user's discretion, . . . .” *Id.*, col. 3, lines 20-23 (emphasis added).

Applicants also respectfully submit that the Waltrous reference fails to teach or suggest “identifying at least one template associated with the type of medical test” as recited in claim 1. The claimed invention includes templates for a variety of different types of medical tests. When a medical test result is received, the appropriate template(s) that correspond with that type of medical test result are identified from all available templates. In contrast, the Waltrous reference does not indicate that its diagnosis includes any templates (as admitted on page 3 of the Office action).

Next, Applicants respectfully submit that the Waltrous reference fails to teach or suggest “selecting a template matching the medial test result.” As noted above, the Waltrous reference fails to teach or suggest that a diagnosis from its system includes any templates. Accordingly, this limitation is necessarily missing from the Waltrous reference. Following from this deficiency, the Waltrous reference also fails to teach or suggest “outputting a plain language explanation based on the selected template.” Moreover, Applicants note that the present invention is concerned with providing a plain language explanation that is understandable by a patient. In contrast, the diagnosis from the system in the Waltrous reference is specifically intended for physicians. Accordingly, the Waltrous reference fails to teach or suggest providing a plain language explanation as recited in independent claim 1.

The Rapaport reference was cited in the Office action in an attempt to show that some differences between the invention of claim 1 and the Waltrous reference are obvious differences. In particular, the Rapaport reference was cited in the Office action to cure the deficiency that the Waltrous reference does not teach or suggest that its system's diagnosis

includes use of a template. *See* Office action, p. 3-4. However, Applicants respectfully submit that there is no suggestion or motivation to combine the Rapaport and Waltrous references.

MPEP § 706.02(j) states that in order to establish a prima facie case of obviousness under § 103:

there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure.

MPEP § 2142 states that “[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. *See in re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” *Dembiczak*, 50 USPQ2d at 1617. “The factual inquiry whether to combine the references must be thorough and searching.” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. *Id.* at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *See in re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Office action does not present any evidence why someone of ordinary skill in the art would have combined the Rapaport and Waltrous references. The sole explanation in the

Office action to combine the Rapaport and Waltrous references is that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the automatic diagnosis features of Waltrous with the templates of Rapaport et al. to supply the patient with specific medical test results, that the patient is able to understand in a secure environment without having the medical provider to continually attempt to contact the patient, saving both time and resources of the medical provider and patient as taught by Rapaport et al.” Office action, p. 4. Instead of showing objective evidence of a proper motivation or suggestion, the Office action has cited simply the benefits of features that are present in the Rapaport reference but are missing in the Waltrous reference as the motivation. By extracting the relevant parts from each of the two references and combining those parts, the Office Action has effectively recreated the invention by using the claim as a blueprint. Neither the Waltrous reference nor the Rapaport reference discloses or suggests a motivation to combine with the other to achieve the claimed invention. The references themselves do not suggest the viability of making the combination, and someone of ordinary skill in the art would not think to combine them. Thus, the references are not properly combined. Therefore, the combination is improper and must be withdrawn.

Additionally, Applicants respectfully submit that there is no suggestion or motivation to modify the Waltrous reference with the Rapaport reference because the modification would change the principle of operation of the system in the Waltrous reference. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” MPEP § 2143.01. The principle of operation of the system in the Waltrous

reference is to analyze acoustic signals to assist physicians in the diagnostic decision process. To modify the Waltrous reference with the Rapaport reference would destroy the principle of operation of the Waltrous system because instead of facilitating physicians in the diagnostic decision process, messages including medical information would be provided to patients. The diagnostic decision process for a physician is a significantly different operation than providing medical information to patient. As such, the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). *See also*, MPEP § 2143.01. Accordingly, Applicants respectfully submit that the modification would change the principle of operation of the system in the Waltrous reference, and thus there is no suggestion or motivation to modify the Waltrous reference with the Rapaport reference.

Further, even if the references were combined, the combination would still fail to teach or suggest multiple limitations of independent claim 1. As note above, the Waltrous reference fails to teach or suggest multiple limitations of the claim 1. The Rapaport reference, which discusses a system for communicating manual interpretations of results to patients, fails to cure these deficiencies. For instance, the Rapaport reference fails to teach or suggest anything remotely similar to “determining if the medical test result will be automatically interpreted independent of clinician input or if the medication test result will be interpreted using clinician input.” In particular, the Rapaport reference is directed to communicating manual interpretations of test results to patients and does not discuss a system that provides automatic interpretations independent of clinician input. The Rapaport reference also fails to teach or suggest “if the medical test result will be automatically interpreted independent of clinician input, identifying at

least one template associated with the type of medical test.” As indicated, the Rapaport reference relies upon a manual interpretation by a clinician and does not discuss a system that provides automatic interpretations. Because the Rapaport reference fails to teach or suggest this limitation, the Rapaport reference necessarily also fails to teach or suggest “selecting a template matching the medical test result; and outputting a plain language explanation based on the selected template.”

In view of the above, it is respectfully submitted that the Waltrous and Rapaport references, either alone or in combination, fail to teach or suggest all the limitations of independent claim 1. As such, independent claim 1 is patentable over the Waltrous and Rapaport references, and Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim. 1.

Each of independent claims 21 and 41 include limitations similar to those recited in independent claim 1. As such, it is respectfully submitted that the Waltrous and Rapaport references, either alone or in combination, fail to teach or suggest all the claim limitations of independent claims 21 and 41 for at least the same reasons as noted above for independent claim 1. Independent claims 21 and 41 are patentable over the Waltrous and Rapaport references, and Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of independent claims 21 and 41.

Claims 2-6 and 8-20 depend from independent claim 1; claims 22-26 and 28-40 depend from independent claim 21; and claims 42-46 and 48-60 depend from independent claim 41. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 2-6, 8-20, 22-26, 28-40, 42-46, and 48-60 as well. Dependent claims



2-6, 8-20, 22-26, 28-40, 42-46, and 48-60 are believed to be in condition for allowance and such favorable action is respectfully requested.

Furthermore, many of these dependent claims are separately patentable because they contain additional limitations not found in the Watrous and Rapaport references. For example, in claims 14, 34, and 54, the system determines whether the selected template can be sent directly to a patient. For instance, in some cases, further physician review may be required prior to sending a selected template to a patient. *See, e.g.*, Application, p. 13, lines 1-6. Page 11 of the Office Action attempts to find this limitation in the Rapaport reference. However, the Rapaport reference is directed towards a medical provider manually selecting a template or entering an “on-the-fly” bulletin and then sending the message out to a physician. This is significantly different than a system determining whether a selected template can be sent directly to a patient. As such, the Watrous and Rapaport references fail to teach or suggest this limitation in context of their respective base claims.

### **CONCLUSION**

For at least the reasons stated above, claims 1-6, 8-26, 28-46, and 48-60 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-6, 8-26, 28-46, and 48-60. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/John S. Golian/

John S. Golian  
Reg. No. 54,702

SHOOK, HARDY & BACON L.L.P.  
2555 Grand Blvd.  
Kansas City, MO 64108-2613  
816-474-6550